

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated September 23, 2004, indicated that claims 1-11, 18 and 19 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,301,607 B1. Claims 1-8, 10-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayle, *et al.* (U.S. Patent No. 6,018,774) in view of Roberts *et al.*, (U.S. Patent No. 6,295,551). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the '774 reference in view of the '551 reference as applied to claim 1 above, further in view of Fredlund *et al.* (U.S. Patent No. 5,666,215).

Applicant submits the attached Terminal Disclaimer removes any rationale for maintaining the rejection of claims 1-11, 18 and 19 under the judicially created doctrine of obviousness-type double patenting. Applicant therefore requests that the rejection of claims 1-11, 18 and 19 be removed.

Applicant respectfully traverses all of the Section 103(a) rejections, each of which relies upon the '774 reference as a primary reference, because the Office Action failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, as indicated in the M.P.E.P., the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In this instance, the Office Action failed to meet all of the criteria for establishing such a Section 103(a) rejection, as discussed below.

Applicant submits that the cited portions of the references fail to teach or suggest all of the claimed limitations of the present invention. As acknowledged on page 4 of the Office Action, the primary '774 reference does not teach or suggest limitations including the use of an internet appliance with internet telephony capability. In an attempt to arrive at the presently-claimed invention, the '551 reference was asserted as teaching for limitations directed to an internet access appliance with internet telephony capabilities. However, the cited portions of the '551 reference do not teach or suggest internet

telephony or an internet telephony appliance. For example, the cited portions of columns 5, 12 and 21 do not discuss internet telephony; rather, they are directed to use with a conventional publicly switched telephone network (PSTN) (*see, e.g.*, FIGs. 5 and 6, where all telephones communicate via PSTN 166 and 167).

Applicant has further reviewed the '551 reference and cannot ascertain any teaching or suggestion of internet telephony applications. For example, reviewing FIGs. 5 and 6 further and in connection with the description, the reference clearly is directed away from Internet telephony (*e.g.*, packet-based telephony) and towards the use of a PSTN system. As indicated in the paragraph beginning at line 60 of column 18 in connection with FIG. 5, telephone communication is carried out over a PSTN 167. Connection is made "through the public telephone network to the local PSTN 167 of the user 162 and to user's phone 164." *See* column 19, lines 1-2. Further, in connection with FIG. 6, column 19, lines 7-41 discuss an approach involving Internet communications that are limited to use with separate telephony communications (via PSTN). Referring to the cited portion of column 21 at lines 25-27 (in connection with the rejection of claim 4), the '551 reference does not teach initiating an internet phone call as asserted. Rather, the call request discussed at lines 25-27 of column 21 in connection with FIGs. 6 and 7b, relates to controlling an automated call distribution system (ACD) 182 for conventional telephone calls over PSTN 167. In this regard, while a "call session" is described in the '551 reference in connection with information communicated via a network and displayed on a computer, the telephony components of the "call session" are limited to PSTN communications.

In view of the above, the '551 reference fails to teach the asserted Internet appliance with Internet telephony capability as asserted in the Office Action. In this regard, the Office Action failed to meet the Section 103(a) requirement that the cited reference(s) teach or suggest all the claim limitations; therefore, the Office Action failed to establish a *prima facie* case of obviousness, and Applicant requests that the rejection be removed.

Applicant further traverses the Section 103 rejection because the Office Action failed to adequately provide evidence of motivation for modifying the primary '774 reference. For example, the allegation that modifying the primary '774 reference "would have improved system effectiveness" fails to show how "effectiveness" would be

improved or to state what “effectiveness” means. At best, this allegation is vague and fails to afford the Applicant an opportunity to judge the propriety of the rejection and to formulate a response thereto, as consistent with 35 U.S.C. §132.

In addition, the stated motivation “to use another possible source of the shared images” is not relevant to the proposed (improper) modification of the primary ‘774 reference. That is, using another source of shared images does not appear relevant to the addition of an internet telephony appliance and use thereof to the primary ‘774 reference. Therefore, one of skill in the art would not consider this alleged “motivation” when making an unrelated modification.

Moreover, the stated motivation “to use another possible source of the shared images” does not apply to the primary ‘774 reference because, as alleged on page 3 of the Office Action, the ‘774 reference already teaches the use of several devices for capturing images. For instance, as indicated at column 7, lines 7-20 of the ‘774 reference, data can be “supplied from a variety of sources” and “[f]or graphical data representing digital photos, various sources of data are possible.” Therefore, one of skill in the art would not be motivated to modify the ‘774 reference with the ‘551 reference in order “to use another possible source of the shared images” because the ‘774 reference already indicates that various such sources are possible.

In view of the above, the motivation asserted for modifying the primary ‘774 reference fails to meet the Section 103 requirement of motivation in that the assertions in the Office Action are vague and do not apply to the specific modifications suggested in the Office Action. Therefore, there is no evidence of motivation for making the asserted modifications. Relevant case law indicates that, without such evidence of motivation, the Section 103(a) rejection should be removed (*see, e.g., In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)).

In view of the above discussion, Applicant believes that the rejections have been overcome and that the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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